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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,210	07/24/2000	GORDON REX PATERSON DOUGAL	9052-53	1793

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MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627

EXAMINER

JOHNSON, HENRY I

ART UNIT	PAPER NUMBER
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3739

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DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/529,210

Applicant(s)

DOUGAL, GORDON REX
PATERSON

Examiner

Henry M Johnson, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Response to Arguments

Applicant's arguments filed April 29, 2003 have been fully considered but they are not persuasive. A declaration of unexpected results cannot overcome 35 U.S.C. 102 rejections. The rejections are sustained.

Response to Amendment

The declaration under 37 CFR 1.132 filed April 29, 2003 is insufficient to overcome the rejection of claim 1 based upon unexpected results as set forth in the last Office action because: Evidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C. 102 rejections and thus cannot overcome a rejection so based. In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973) (MPEP § 2131.04).

The device of Salansky is disclosed as radiating within the range of 400-2000 nm. For treating ulcers, Table 5 provides a more specific range of 800-1100 nm. The 1072 nm claimed by the applicant is within this more specific range. Salansky further teaches a total bandwidth of 40 nm and densities of 1 to 5 W/cm². Thus Salansky clearly anticipates claim 1.

The unique or unexpected results of specific wavelengths in treating specific conditions are not relevant to apparatus claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 6-10, 12 and 15-24 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,063,108 to Salansky et al. Salansky et al discloses an apparatus for treating tissue that uses radiation in the range of 400-2000nm (Col. 3, line 44) with an intensity of from 0.2 to 5000 mW/cm². The power intensity anticipates the **at least** 50 μ W/cm² and 500 μ W/cm². Salansky et al teaches the full bandwidth should not exceed 30 to 40 nm (Col. 16, line 42). Salansky is capable of operating at either 1072 nm or 1268 nm (these fall within the operating range), and with a stated bandwidth of 30 to 40 nm, the radiation is well within the 980 to 1300 nm requirement. The apparatus may use light emitting diodes (Col. 3, line 51) that inherently produce divergent radiation or a laser or laser diode may also be used as the source. Diodes, by definition, include a PN junction. Salansky et al teaches the radiation can be either pulsed or continuous with average powers adjustable by the processor over a wide range by varying the pulse repetition rates over a wide range of hertz and the pulse durations from nanoseconds to milliseconds (Col 14, line 31). The treatments disclosed by Salansky et al, provide exposure times from 3 to 500 seconds (Table 8) and dosages in Joules/ cm² (Table 5) as is common in the art. A central processor is disclosed that stores the selected parameters for operating the apparatus to meet specific treatment protocols (Col. 21, lines 40-44) and effectively limit the radiation to specific ranges. A display shows system parameters such as timer, power, and frequency (Col. 23, line 24). Salansky et al teaches treating numerous afflictions including herpes (Col. 37, line 17). Figure 13 shows a flexible applicator that can be wrapped around the surface contours of the body (Col. 26, line 1) that provides the means of reducing all ambient light.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,063,108 to Salansky et al. Salansky et al does not disclose expressly the specific divergence of the emitting device. Applicant has not disclosed that the increased beam divergence provides any advantage or unexpected result. Light emitting diodes are commercially available with a wide range of divergent specifications. Therefore, pending a statement of criticality, the cited divergence is considered to be an obvious design choice to one having ordinary skill in the art.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,063,108 to Salansky et al. Salansky et al does not teach a specific average power, but does teach that average power is less than peak power (Col. 6, line 41) and may be changed by varying the pulse repetition rate and pulse duration (Col. 14, lines 29-33). It would have been obvious to one having ordinary skill in the art to manipulate the pulse and repetition rate to obtain the desired average power.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,063,108 to Salansky et al. Salansky et al cites repetition frequencies from 0 to 200 Hz and 1000 to 10,000 Hz, yet does not disclose 201 to 999 Hz specifically. Applicant has not disclosed that the specific repetition rate provides any advantage or unexpected result. Salansky et al teaches treatment routines for many different afflictions that are programmed as protocols into the processor that controls the frequency, pulse width and repetition rate. "Where

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the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). The cited frequency/repetition rate is considered to be an obvious design choice to one having ordinary skill in the art.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,063,108 to Salansky et al in view of Lasers and Electro-Optics by Christopher C. Davis, Cambridge University Press 1996, page 289. Salansky et al does not specifically disclose a diode with multiple PN junctions. The use of multiple PN junctions is old and well known in the art of LED construction as disclosed by Lasers and Electro-Optics by Christopher C. Davis, thereby making their use an obvious design choice.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,063,108 to Salansky et al in view of U.S. Patent 5,527,350 to Grove et al. Salansky et al is discussed above. Grove discloses the use of gas lasers (Col. 1, line 56) in tissue treatment. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a gas laser as disclosed by Grove et al in the device of Salansky et al to obtain the wavelength desired for treatment.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

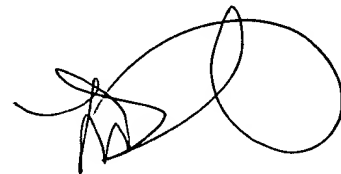
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M Johnson, III whose telephone number is (703) 305-0910. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Henry M Johnson, III
Patent Examiner
Art Unit 3739

Hmj
July 23, 2003

A handwritten signature in black ink, appearing to read 'Linda C. M. Dvorak', with a large, stylized loop at the end.

LINDA C. M. DVORAK
SUPERVISORY PATENT EXAMINER
GROUP 3700